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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/403,329	10/26/2000	Paul Mueller	33900-56PUS	7124

7590 02/26/2003

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EXAMINER

SHIPSIDES, GEOFFREY P

ART UNIT	PAPER NUMBER
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1732

DATE MAILED: 02/26/2003

14

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/403,329

Applicant(s)

MUELLER ET AL.

Examiner

Geoffrey P. Shippides

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 December 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 15-19 and 21-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 15-19 and 21-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claim 23 is rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,614,146 (Nakamura et al.).

Nakamura et al. teaches a method of and apparatus for injecting molding a receptacle fitted with a covering label (title), where the label is flat before it is inserted into the mold (figure 3), but is put into an un-flattened configuration prior to insertion into the mold (figure 4), the two edges of the label are brought together (figure 5), the label is inserted into the mold prior to molding (figure 8), the mold includes a mold core (figure 8, ref. No. 7), a mold matrix (figure 8, ref. No. 6), and a molding space between the core and the matrix. Nakamura et al. teaches a movable pneumatic gripping means (figure 3) that grips labels by the outside face of the label (Column 3, lines 39-54, column 4, lines 30-34, and figure 3). Nakamura et al. teaches that the label is then transferred to a pseudo core, then to the mold, then the mold is closed and plastic material is then introduced into the molding space.

With regard to claim 23, The apparatus of Nakamura et al. includes a mold having a male portion and a female portion for molding a receptacle and operable to

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receive a covering label (figure 8), and also includes a movable pneumatic transfer element for pneumatically gripping a label by contacting the outside face of the label.

The limitation of the label comprising at least two edges that have been joined together and the limitation that the movable pneumatic transfer element is used to deposit the label on the male portion of the mold are both intended uses of the apparatus and have little patentable weight.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 15-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,614,146 (Nakamura et al.).

Nakamura et al. teaches a method of injecting molding a receptacle fitted with a covering label (title), where the label is flat before it is inserted into the mold (figure 3), but is put into an un-flattened configuration prior to insertion into the mold (figure 4), the two edges of the label are brought together (figure 5), the label is inserted into the mold prior to molding (figure 8), the mold includes a mold core (figure 8, ref. No. 7), a mold matrix (figure 8, ref. No. 6), and a molding space between the core and the matrix. Nakamura et al. teaches a movable pneumatic gripping means (figure 3) that grips labels by the outside face of the label (Column 3, lines 39-54, column 4, lines 30-34, and figure 3). Nakamura et al. teaches that the label is then transferred to a pseudo

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core, then to the mold, then the mold is closed and plastic material is then introduced into the molding space.

With regard to claim 15, Nakamura et al. does not specifically teach the thickness of the label. It is the examiner's position that the it is well known in the art of supplying labels to products to use labels of the thinnest possible thickness that allows for an appropriate appearance in order to reduce the amount of material used. It would have been obvious to one having ordinary skill in the art at the time of invention to use a label with a thickness of less than or equal to 80 microns in the process of Nakamura et al. in order to minimize the material cost of the labels. It would have been further obvious to one having ordinary skill in the art at the time of invention to determine the optimal label thickness for a desired product appearance and cost through routine experimentation.

Further, although Nakamura et al. teaches the transfer of the label from a movable pneumatic gripping means that grips the outside of the label to a pseudo core that places the label into the mold prior to the closing of the mold. The examiner notes that this instant limitation does not require the core which deposits the label to be part of the closed mold.

Also, although Nakamura et al. does not specifically teach the sealing of the two edges of the label together when the label is put into the pseudo core, the label is shown with the respective ends pressed together on the pseudo core (figure 5). It is the examiner's position that these edges are intrinsically sealed together during the injection molding step as taught by Nakamura et al. as the step of injection molding bonds these two edges together.

With regard to claim 16, Nakamura et al. does not specifically teach the thickness of the label. It is the examiner's position that the it is well known in the art of supplying labels to products to use labels of the thinnest possible thickness that allows for an appropriate appearance in order to reduce the amount of material used. It would have been obvious to one having ordinary skill in the art at the time of invention to use a label with a thickness of less than or equal to 50 microns in the process of Nakamura et al. in order to minimize the material cost of the labels. It would have been further obvious to one having ordinary skill in the art at the time of invention to determine the optimal label thickness for a desired product appearance and cost through routine experimentation.

With regard to claim 17, Nakamura et al. teaches the use of a label supplying means that uses a known label feeder (Column 3, lines 39-45). It is the examiner's position that this constitutes a stack of labels or a magazine. Nakamura et al. teaches that each label is extracted (Column 3, lines 39-53) and that each label is un-flattened prior to introducing the label to the mold (figure 4). Even if the label supplying means as taught by Nakamura et al. does not constitute a stack of labels or a magazine, it is notoriously well known in the art to use stacks of labels or magazines to supply flat materials (such as paper or labels) and it would have been obvious to one having ordinary skill in the art to use a stack of labels or a magazine to supply the labels in order to provide an easy and efficient means of supplying and storing labels prior to the use of the labels in the injection molding process as taught by Nakamura et al.

With regard to claim 19, the label is intrinsically engaged around the mold core as shown in Figs. 4 and 5 and is thrust around the mold core using a vacuum means (Figure 4, element 21b).

5. Claims 21 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,614,146 (Nakamura et al.) as applied to claims 15-17 above, and further in view of admitted prior art (Admission).

With regard to claims 21 and 22, labels are made of a variety of materials, including paper and polypropylene as taught by the Admission (Page 2, lines 3 and 4 of the instant specification). It would have been obvious to one having ordinary skill in the art at the time of invention to use the method as taught by Nakamura et al. with labels made out of paper and polypropylene as taught by Admission in order to produce articles with a cost effective label type of choice.

6. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,614,146 (Nakamura et al.) as applied to claims 15-17 above, and further in view of U.S. Patent No. 3,602,496 (Langenohl), U.S. Patent No. 6,159,568 (Freedman et al.), U.S. Patent No. 4,986,866 (Ohba et al.), and U.S. Patent No. 4,992,038 (Furuse et al.).

With regard to claim 17, even if the label supply means as taught by Nakamura et al. does not constitute a magazine, it is well known in the art to supply labels in stacks in magazines, and to extract the label from the magazine in order to supply the label to a mold. Langenohl, Freedman et al., Ohba et al., and Furuse et al. are cited merely to demonstrate that it is known in the art to supply labels in stacks in magazines.

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It would have been obvious to one having ordinary skill in the art at the time of invention to provide the labels to the process of Nakamura et al. by a magazine as is well known in the art to facilitate the process of feeding labels to the gripping means. Nakamura et al. further teaches that each label is extracted (Column 3, lines 39-53) and that each label is un-flattened prior to introducing the label to the mold (figure 4).

7. Claims 24 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,614,146 (Nakamura et al.) in view of U.S. Patent No. 3,602,496 (Langenohl), U.S. Patent No. 6,159,568 (Freedman et al.), U.S. Patent No. 4,986,866 (Ohba et al.), and U.S. Patent No. 4,992,038 (Furuse et al.).

Nakamura et al. teaches a method of and apparatus for injecting molding a receptacle fitted with a covering label (title), where the label is flat before it is inserted into the mold (figure 3), but is put into an un-flattened configuration prior to insertion into the mold (figure 4), the two edges of the label are brought together (figure 5), the label is inserted into the mold prior to molding (figure 8), the mold includes a mold core (figure 8, ref. No. 7), a mold matrix (figure 8, ref. No. 6), and a molding space between the core and the matrix. Nakamura et al. teaches a movable pneumatic gripping means (figure 3) that grips labels by the outside face of the label (Column 3, lines 39-54, column 4, lines 30-34, and figure 3). Nakamura et al. teaches that the label is then transferred to a pseudo core, then to the mold, then the mold is closed and plastic material is then introduced into the molding space. The apparatus of Nakamura et al. includes a mold having a male portion and a female portion for molding a receptacle and operable to receive a covering label (figure 8), and also includes a movable pneumatic transfer

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element for pneumatically gripping a label by contacting the outside face of the label.

The limitation of the label comprising at least two edges that have been joined together and the limitation that the movable pneumatic transfer element is used to deposit the label on the male portion of the mold are both intended uses of the apparatus and have little patentable weight.

With regard to claim 24, even if the label supply means as taught by Nakamura et al. does not constitute a magazine, it is well known in the art to supply labels in stacks in magazines, and to extract the label from the magazine in order to supply the label to a mold. Langenohl, Freedman et al., Ohba et al., and Furuse et al. are cited merely to demonstrate that it is known in the art to supply labels in stacks in magazines. It would have been obvious to one having ordinary skill in the art at the time of invention to modify the apparatus of Nakamura et al. by using a magazine as the feeding means as is well known in the art to facilitate the process of feeding labels to the gripping means. Nakamura et al. teaches a process of un-flattening a label using an element (figure 4). The pseudo core as taught by Nakamura et al. constitutes an element for expanding the flattened label that contacts an outside face of the label (Figure 4).

With regard to claim 25, the pneumatic transfer element as taught by Nakamura et al. (figures 3 and 4, ref. No. 11) also constitutes a blowing means (Column 4, lines 45-59) in the un-flattening (or expanding) of the label.

8. Claims 18 and 26-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,614,146 (Nakamura et al.) as applied to claims 15-17 above, and further in view of U.S. Patent No. 4,479,771 (Slat et al.).

With regard to claim 18, Nakamura et al. does not specifically teach the use of multiple gripping means to simultaneously grip multiple labels and insert each label into a different mold cavity. Slat et al., however, teaches the use of multiple gripping means to place a plurality of labels into a plurality of mold cavities (figure 1). It would have been obvious to one having ordinary skill in the art at the time of invention to have proved for multiple gripping means for the simultaneous collection of multiple labels in the process and apparatus of Nakamura et al. in order to allow for the molding of multiple labeled articles simultaneously in order to speed up the production cycle of labeled articles.

With regard to claims 26 and 27, Nakamura et al. does not specifically teach that the movable pneumatic transfer support element comprises a plurality of elements each for gripping a label or a multi-cavity mold. Slat et al., however, teaches a multi-cavity mold and a transfer element that grips a plurality of labels. It would have been obvious to one having ordinary skill in the art at the time of invention to modify the apparatus of Nakamura et al. include multiple transfer elements (each for gripping a label) on a single transfer element and a multi cavity mold as taught by Slat et al. in order to provide for an apparatus for simultaneously producing labeled containers in order to increase the productivity of the apparatus. It is noted that the type of labels transported (expanded or not) in an intended use type limitation and has no patentable merit.

With regard to claim 28, Nakamura et al. does not specifically teach the use of robot to move the movable pneumatic transfer support element, but Nakamura et al. does teach that it is swingable around a reference point (Column 3, line 46). It is

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notoriously well known in the art to use robotics to move apparatus parts. It would have been obvious to one having ordinary skill in the art at the time of invention to use a robot to move the movable pneumatic transfer support element of Nakamura et al. in order to accurately and precisely place the label in the desired position each and every time. Further, it is also well known to use robotic arms with various axes of rotation and/or translation and it would have been obvious to provide a robotic arm on the movable transfer support element of Nakamura et al. that sufficient axes of rotation and translation that allows for the labels to be properly placed in the mold.

With regard to claim 29, it is further the examiner's position that the mold itself is a means for engaging the expanded label in part of the mold core and is also a means for thrusting the label onto the mold core (as the mold closes).

Response to Arguments

9. Applicant's arguments with respect to claims 15-29 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not

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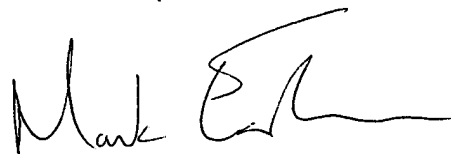
mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Geoffrey P. Shipsides whose telephone number is 703-306-0311. The examiner can normally be reached on Monday - Friday 9 AM till 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard D Crispino can be reached on 703-308-3853. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

Geoffrey P. Shipsides/gps
February 24, 2003



MARK EASHOO, PH.D
PRIMARY EXAMINER

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24 / Feb / 03